

REMARKS

In the outstanding Office Action, the Examiner asserts that applicant's reply, mailed on January 22, 2002, is not fully responsive to the prior Office Action because it allegedly is unclear whether applicant addressed the lack of written description rejection in his enablement arguments. In addition, the Examiner asserts that applicant has not addressed the objection to claim 54.

Applicant is herein amending claim 54 to correct a typographical error so that it properly depends from claim 53 (not claim 35). Support for the amendment may be found on page 12, lines 13-14. Applicant submits that the amendment does not introduce new matter and is fully supported by the specification, as originally filed. In view of this amendment, applicant requests that the Examiner withdraw the objection to claim 54.

Although applicant believes that his previous reply was fully responsive with respect to all of the rejections – both written description and enablement – under 35 U.S.C. § 112 (first paragraph), applicant nonetheless provides the following further explanation of why his specification clearly meets the written description requirement under 35 U.S.C. § 112 (first paragraph).

The Examiner alleges that claims 1, 2, 5-19, 21-29, 31, 34-44, 46, 48-57 fail to meet the written description requirement with respect to:

- (1) the genus of arylpropionic acids; and
- (2) proteins other than serum albumin that bind arylpropionic acid.

Applicant traverses this rejection because the specification fully and clearly conveys the claimed subject matter to those skilled in the art at the time of applicant's filing date.

Applicant respectfully submits that, as opposed to the adequacy of the written description of the currently claimed invention, the Examiner is actually challenging the adequacy of the enablement of the claimed invention – a rejection to which applicant responded in his previous reply. Although the Examiner asserts that applicant has not disclosed any particular examples of or further defined a "protein that resides, in part, in the circulating serum and in part in a non-circulating portion of the vascular system" (Office Action at page 6, lines 6-7), this is a challenge to the enablement requirement, not written description. Furthermore, applicant submits that the "making and using" and "clear and concise and exact term" language to which Examiner refers in his rejection relates to the enablement prong of 35 U.S.C. § 112 (first paragraph), not the written description prong.

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In order to establish a *prima facie* case to support a rejection for alleged lack of written description, the Examiner bears the burden of proving the following elements:

1. The application does not reasonably describe or convey the concept of the invention
2. to one of ordinary skill in the art
3. at the time of filing the patent application
4. of the currently claimed invention.

Ex parte Parks, 30 USPQ2d 1234 (B.P.A.I. 1994). Furthermore, under the Written Description Guidelines, for each new or amended claim or claim asserting the benefit of an earlier filing date, the Examiner must determine the scope of the claims compared to the original claims and/or the earliest priority or benefit application disclosure.

Applicant respectfully submits that the Examiner has failed to establish the *prima facie* case because he has not proven that the application does not reasonably convey the invention, as currently claimed. Applicant further submits that the Examiner has improperly applied the Written Description Guidelines.

This patent application is a continuation-in-part application of co-pending Application Serial No. 09/334,130. In this application, applicant originally filed a specification with 54 claims. Applicant subsequently filed a Preliminary Amendment, wherein he canceled claims 3, 4, 20, 30, 33, 45 and 47, added new claims 55-57 and amended claims 1, 2, 5, 6, 11, 13, 21, 26, 29, 31, 34, 39, 40, 42-44, 46, 48 and 53. Although the written description analysis requires a review of each claim individually, applicant submits that none of the new or amended claims are broader in scope in comparison to the originally filed claims. The new or amended claims are either of the same scope or narrower in scope in comparison to the originally filed claims. For those claims that are of the same scope, applicant submits that the written description requirement is clearly met (See Decision Tree on page 6 of Guidelines). For those claims that are of narrower scope, applicant submits that there is *express* support for the claims as a whole. Thus, the claims meet the written description requirement (*Id.*).

The Examiner mistakenly suggests that the specification does not provide adequate written description for

- (1) the genus of arylpropionic acids; and
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(2) proteins other than serum albumin that bind arylpropionic acid.

In the specification, on page 12, line 17, *inter alia*, applicant ***expressly*** discloses the genus of "arylpropionic acids." In claim 7, as originally filed, and the specification, *inter alia*, at page 13, lines 15-18, as originally filed, applicant ***expressly*** discloses that the invention is directed to cellular, serum and vascular proteins – not just albumin. Applicant has not broadened the scope of any of the claims with the amendments or additional claims and those claims that have been amended are ***expressly*** supported as a whole by the application, as originally filed, and thus must meet the written description requirement.

In view of the foregoing, applicant respectfully requests that the Examiner withdraw the rejection of claims 1, 2, 5-19, 21-29, 31, 34-44, 46, 48-57 under 35 U.S.C. § 112 (first paragraph) for failing to meet the written description requirement.

Conclusions


Applicant requests that the Examiner:

- (1) enter the amendment;
- (2) reconsider and withdraw the rejections of and objections to the claims; and
- (3) pass claims 1, 2, 5-19, 21-29, 31, 32, 34-44, 46 and 48-57 to allowance.

If the Examiner is of a contrary view, the Examiner is requested to contact the undersigned attorney at (215) 557-3861.

Attached hereto is a marked-up version of the changes made to the specification and the claims by the current amendment. The attached page is captioned "VERSION WITH MARKINGS TO SHOW CHANGES MADE."

Respectfully submitted,



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VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the claims:

54. (amended) The method of claim [35] 53 wherein said protein is a cell surface integrin.